

No. 14399

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

D & H ELECTRIC COMPANY, a corporation,

Appellant,

vs.

M. STEPHENS MFG., INC., a corporation, and JACK Mc-
LOUGHLIN, doing business as McLoughlin Sales,

Appellees.

BRIEF OF APPELLEES RE APPELLANT'S PETITION FOR A REHEARING.

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Appellees submit that this Honorable Court's construction of appellant's claim is proper, and is indeed the only construction which can be justified. Both the patent and the file wrapper reveal that the patentees consider that their invention consisted of ribs at right angles. The broader construction suggested by appellant would render the patent invalid.

The statement of the invention made by this Court in its recent opinion in this case accurately defines the disclosure of the patent as it is claimed. This Court stated that the patent in suit

" . . . covers a combination of elements in a tubular member that has (a) a series of ribs extending substantially at right angles to its major axis, and (b) said ribs defining a spiral having a greater helical

angle than the normal helical angle of the convolutions of the conduit.”

Each of these characteristics will now be separately considered.

Spacing of the Ribs.

Appellant argues that the difference between the 9° helical angle of the conduit and the 12° helical angle of the one-inch coupling is *ipso facto* proof of a misfit. The figures taken by appellant are extreme, for by the testimony of its own expert, the helix angle of this coupling is *either* 10° *or* 12°, and not necessarily 12°. There is no showing in the record that a 90° conduit would be expanded longitudinally by a 10° coupling. The difference is too slight; there is more “play” than that between the coupling and the conduit.

Moreover, the spacing of the ribs *per se* is not an important issue in this case. This is for the reason that the only claim of the patent calls for this feature *in combination* with the right angle feature. That portion of the claim that defines the spacing of the ribs is, therefore, merely one limitation of the claim. The appellant is now estopped to assert this feature by itself, since it accepted the Patent Examiner’s final rejection of the claim specifically directed only toward the spacing of the ribs. Appellant is not now allowed an interpretation of the claim in the patent that would revive the claim which the patentees cancelled in order to get the patent in suit. [R. pp. 176-177.]

Texas Co. v. Anderson-Pritchard Refining Corp.
(C. A. 10, 1951), 122 F. 2d 829, 842;

Tampax, Inc. v. Personal Products Corp. (C. A. 2, 1941), 123 F. 2d 722.

Appellees Use Interrupted Threads.

The appellant has conceded that the prior art discloses interrupted screw threads. The appellees submit that the ribs used on the devices manufactured by appellees are interrupted screw threads, as held by this Honorable Court and the trial court. The physical evidence is believed to prove this. During the actual tests at the trial, the patented coupling was inserted into a conduit, and then disconnected; the ribs of the coupling were scratched on the *sides of the ends*—showing that this is where the ribs contacted the convolutions of the conduit and exerted a longitudinal pressure on the conduit. However, when the coupling of the appellees was inserted into a conduit and then disconnected, the ribs were scratched along the *tops*, showing that the ribs exerted an outward pressure on the conduit and not a longitudinal pressure. Compare Exhibits 3 and 18, respectively. [R. pp. 78, 80.] This outward pressure feature is old in the prior art, as shown by the Hunter patent, No. 1,775,128. [Deft. Ex. C; R. p. 154.]

Expert Testimony.

The argument of the appellant that the ribs used on the couplings manufactured by the appellees are not mutilated screw threads, is believed entirely founded on the testimony of its expert witness. Appellant would have the claim for ribs placed “substantially at right angles” include all interrupted screw threads having a helical angle greater than the helical angle of the conduit.

The patent expert, who was also examined as a mechanical expert, did not realize that any rib placed off of the right angle automatically becomes a thread. Yet this is what happens, because the line of projection of any such

rib around the body of the tubular member, even if the rib is at an angle of only one degree to the right angle, will not return to the point of beginning. The precise meaning of an interrupted thread is that the intermediate thread or threads are omitted. There are also threads known as multiple threads. If this type of thread were to be broken or mutilated or interrupted, the line of projection of one rib would probably never intersect the next succeeding rib. Thus, the ribs used on the accused couplings are mutilated screw threads. As this Court has said, in view of the prior patents showing mutilated screw threads, the appellant cannot now insist that interrupted screw threads are within the scope of the claim of the patent.

Appellant's expert offered no technical evidence to prove his point as to what, in his opinion, constitute screw threads. Appellees brought out the fact that the physical evidence proved, because of the scratch marks, how the appellees' couplings functioned differently than appellant's when connected with a conduit. The appellant's expert "didn't have time" to do this. [R. p. 100.] Therefore, his opinions that the modes of operation of the two couplings are identical must be disregarded. It is inconsistent with what actually happens in operation or use of the two couplings. See *Solomon v. Renstrom* (C. A. 8, 1945), 150 F. 2d 805, 808, as follows:

"The credibility of all witnesses, including experts, and the weight to be given their testimony, is to be determined by the trier of facts, and the court is not bound to accept the opinion of experts as more than advisory, even though such testimony may be undisputed. In the instant case, the trial court specifically held that it must necessarily reject the testimony of these experts because, 'I am unable to

find in their testimony anything that persuades me to follow their contention.' *The interpretation of the claims of a patent is not to be determined by the opinion of experts, but is a question of law for the court.* Gasifier Mfg. Co. v. General Motors Corp., 8 Cir., 138 F. 2d 197 [59 U. S. P. Q. 259]; American Insurance Co. v. Scheufler, 8 Cir., 129 F. 2d 143; Singer Mfg. Co. v. Cramer, 192 U. S. 265; Sanitary Refrigerator Co. v. Winters, 280 U. S. 30 [3 U. S. P. Q. 40]." (Emphasis added.)

File Wrapper Estoppel.

Angelus Sanitary Can Machine Co. v. Wilson (C. A. 9, 1925), 7 F. 2d 314, is not in point. In that case, this Court held that the patent in suit was entitled to a ". . . fairly liberal range of equivalents." In the case at bar, the degree of invention is slight and the range of equivalents is narrow. Under no interpretation can the accused device be considered as equivalent to the claim. (See App. Br. pp. 4-10.) If the claim in suit were interpreted broadly enough to cover appellee's mutilated threads, it would be invalid in view of the prior patents which admittedly show mutilated threads.

On making reference to the *Angelus Sanitary Can* case, *supra*, it will be seen that this Court applied the rule concerning the doctrine of estoppel as that rule was stated by Judge Sanborn in the case of *National Hollow Brake Beam Co. v. The Interchangeable Brake Beam Co.*, 106 Fed. 693. This Court quoted the rule, as it was given by Judge Sanborn, as follows:

"The description in a specification or drawing of details which are not, and are not claimed as, essential elements of a combination, is the mere pointing out of the better method of using the invention.

* * * A reference in a claim to a letter or figure used in a drawing and in the specification to describe a device or an element of a combination does not limit the claim to the specific form of that element there shown, *unless that particular form was essential to, or embodied the principle of, the improvement claimed.*" (Emphasis added.)

Thus it is seen that the rule, as it is defined, is very different from the way appellant urges that it now be applied. Furthermore, it is obvious that the rule should not be applied in the instant case in the same way that it was applied in the *Angelus Sanitary Can* case, for the instant case is covered by the exception to the rule, which has been italicized in the above quoted passage. The file wrapper makes it abundantly clear that the right angular arrangement of the rib claimed by the patentees is essential to their invention, and embodies the principle of the improvement claimed.

The appellant has attempted to distinguish the *Tampax* case, *supra*, which this Court applied in its opinion. (*Tampax, Inc. v. Personal Products Corp.* (C. A. 2, 1941), 123 F. 2d 722.) The implication of appellant's argument appears to be that this Court should not look to the file wrapper to see what is meant by "substantially." This argument is believed to be contrary to the well-established rule followed not only in this Circuit but also in other Circuits in this country, of looking to the file wrapper to determine the meaning of a word. Therefore, it is believed that this Court was correct that the *Tampax* case is "peculiarly applicable" to the instant case. See the *Schnitzer* case, quoted below.

The appellant has quoted a passage from the case of *Hoe and Co. v. Goss Printing Press Co.*, 30 F. 2d 271

C. A. 2). It implies that the rule in regard to file wrapper estoppel is different in that Circuit than it is in this Circuit. However, this argument is not believed to be valid either, as will be seen from the following quotation taken from the case of *Schnitzer v. The California Corrugated Culvert Co.* (C. A. 9, 1944), 140 F. 2d 275, 276:

“The claim is to be read in connection with the specifications. [Citing cases.] Where the claim uses broader language than the specifications, reference may be had to the latter for the purpose of limiting the claim. *McClain v. Ortmyer*, 141 U. S. 419, 12 S. Ct. 76, 35 L. Ed. 800; *Magnavox Co. v. Hart & Reno*, 9 Cir., 73 F. 2d 433; *Lanyon v. M. H. Detrick Co.*, 9 Cir., 85 F. 2d 875. The file wrapper contains evidence that the inventor understood this element of his claim in the narrower sense. * * * While it is the rule in this circuit that admissions made by the applicant to the examiner are not to be used to narrow the scope of his claim unless he has made changes in his application pursuant to the examiner’s suggestions *yet the proceedings may be used to aid in construing the claim.* *Warren Bros. Co. v. Thompson*, 9 Cir., 293 F. 745.” (Emphasis added.)

The *Schnitzer* case was, of course, cited by the trial court in the present case, and, in fact, regarded by the trial court as controlling. The appellees believe that that case is also “peculiarly applicable” to the present case. The trial court, by its application of the *Schnitzer* case, decided that the claim of the patent in suit was not broad enough to read on the coupling manufactured by the appellees. This was for the reason that these appellees’ coupling had both a different means (the ribs placed at an angle to the right angle) and a different mode of

operation (the outward expansion rather than elongation of the conduit). Consequently, it was the opinion of the trial court that the accused couplings did not infringe the limited claim of the patent in suit. This finding of the trial court, concurred in by this Honorable Court, is not clearly erroneous, and the appellant has not shown it to be clearly erroneous.

Re Samples.

In regard to the few samples the appellees passed out to certain customers, the trial court noted that this was done several years ago, and has not been done since. Furthermore, no sale or use was ever made of them. The Court then noted that this was an equity case, and it did not see any reason for issuing an injunction against the appellees at this late date for an act done several years ago. This was particularly true since there was no likelihood of a resumption thereof. This decision by the trial court was not clearly erroneous.

The case the appellant cited in this respect, *Carter Crume Co. v. American Sales Book Co.* (N. Y., 1903), 124 Fed. 903, can be easily distinguished. In that case the defendant not only manufactured samples of the patented device, *but also threatened to sell such devices.* Therefore, an injunction was granted against the defendant because the equities were against him. As indicated above, this situation does not prevail in the present case, and, therefore, the *Carter Crume* case is not applicable.

Conclusion.

It is the opinion of the appellees that the petition for the rehearing which has been brought by the appellant is based solely upon appellant's contention that both the trial court and this Honorable Court were in error in holding that appellees' angular ribs were merely mutilated screw threads. The appellees believe that both the trial court and this Honorable Court were correct in recognizing that the ribs placed on the accused devices are mutilated screw threads, because (1) the markings showed that appellees' couplings, when screwed in place, followed the contour of the threads within the conduit, and (2) since the appellees' threads are at an angle, a projection of any one of appellees' ribs would never return to the same rib, showing that appellees' ribs are segments of spiral screw threads.

It is, therefore, respectfully submitted that appellant's petition for a rehearing should be denied.

Respectfully submitted,

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